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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,026	07/30/2003	Carl K. Esche	EP-7604	7776

34769 7590 07/27/2005

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/630,026

Applicant(s)

ESCHE, CARL K.

Examiner

Ellen M. McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/23/03; 6/1/05</u> | 6) <input type="checkbox"/> Other: ____  |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al (5,942,470).

Norman et al ["Norman"] disclose gear oils and gear oil additive concentrates which comprise (i) at least one oil-soluble sulfur-containing extreme pressure or antiwear agent, (ii) at least one oil-soluble amine salt of a partial ester of an acid of phosphorus, and (iii) at least one oil-soluble succinimide ashless dispersant, wherein the proportions of (i):(ii):(iii) on a weight basis is (1-5):(0.1-3):(0.05-4). See column 1, line 40 to column 2, line 10. Component (ii) which includes alkylamine salts of phosphorus acids are represented by formulas (I), (II) and (III) in column 4, top, wherein each of the X groups is, independently, an oxygen atom or a sulfur atom. Thus monothiophosphates are encompassed when one X group is a sulfur atom and the other X groups in the same molecule are oxygen atoms. Several of the specific compounds are set forth in columns 4-10 and include several monothiophosphate compounds such as octylamine salt of O,O-dibutylthiophosphoric acid. The examiner is of the position that component (ii) of Norman meets the limitation in the claims of the alkylamine salt of a dialkylmonothiophosphate component. Norman teaches that nitrogen-containing ashless dispersants may also be added to the composition. See columns 14-15 wherein component (v) is

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set forth which includes conventional ashless dispersants including the Mannich-type dispersants. Norman teaches that the additive concentrates contain an oleaginous diluent. See column 18, lines 17-39. Norman allows for the addition of other conventional additives to the gear oils and to the gear oil additive concentrates. Such additives include antioxidants, detergents and pour point depressants. See column 19, lines 29-60. The examiner is of the position that Norman meets the limitations of the above rejected claims which are drawn to an oil soluble lubricant additive package comprising (1) at least one alkylamine salt of a dialkylmonothiophosphate and (2) another component such as a detergent, a dispersant, an antioxidant or a pour point depressant. The open-ended claim language "comprising" allows for the addition of other components to the additive packages. The examiner is of the position that the gears disclosed in Norman are an example of a "machine" lubricated by the gear oil compositions disclosed.

***Claim Rejections - 35 USC § 103***

Claims 25-46 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al (5,342,531).

Walters et al ["Walters"] disclose lubricating oil compositions suitable for use as gear oils which comprise a major proportion of a polyalkylene glycol and a minor proportion dissolved therein of (a) at least one sulfur-containing antiwear or extreme pressure agent, (b) at least one amine salt of at least one partially esterified monothiophosphoric acid, and (c) at least one amine salt of at least one partially esterified phosphoric acid. The examiner is of the

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position that component (b), set forth in column 2, line 21 to column 4, line 9, meets the limitation of the at least one alkylamine salt of a dialkylmonothiophosphate component of the claims. Walters also allows for the addition of other components to the lubricant compositions or additive concentrates such as sterically hindered phenolic and amine antioxidants. See column 6, line 31 to column 7, line 45. Additive concentrates and industrial gear applications are set forth in column 9, lines 20-34. The examiner is of the position that Walters meets the limitations of the above rejected claims which are drawn to an oil soluble lubricant additive package comprising (1) at least one alkylamine salt of a dialkylmonothiophosphate and (2) another component such as an antioxidant. The open-ended claim language "comprising" allows for the addition of other components to the additive packages. The examiner is of the position that the gears disclosed in Walters are an example of a "machine" lubricated by the gear oil compositions disclosed.

### ***Conclusion***

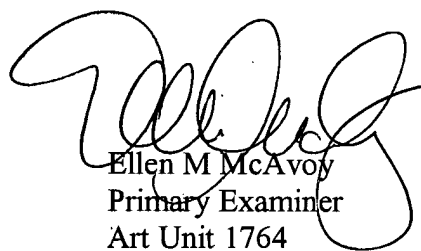
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
July 25, 2005